

## REMARKS

### I. Introduction

Claims 1 to 14 are pending in the present application. In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

### II. Rejection of Claims 1, 2, 5, 6 and 11 Under 35 U.S.C. §103(a)

Claims 1, 2, 5, 6 and 11 were rejected as unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 3,992,992 ("Smith") in combination with U.S. Patent No. 3,335,663 ("Harenza") and U.S. Patent No. 5,241,905 ("Guaraldi et al."). Applicants respectfully submit that the combination of Smith, Harenza and Guaraldi et al. does not render obvious claims 1, 2, 5, 6 and 11 for the following reasons.

Independent claim 1 relates to a lithographic newspaper printing press with at least one printing unit, the printing press printing a newspaper page. Claim 1 recites that the printing unit comprises a housing, having a first side wall and a second side wall, and a first and a second plate cylinder, each being rotatably mounted in the housing. Claim 1 further recites that the printing unit includes first and a second blanket cylinders, associated with the first and second plate cylinders, and an axially removable continuous blanket sleeve mounted on each of the first and second blanket cylinders. Claim 1 further recites that the plate cylinders have a length of substantially four times the width of the newspaper page and a circumference substantially equal to the height of the newspaper page. Claim 1 further recites that each of the first and second plate cylinders carries four flexible printing plates. Claim 1 further recites that the flexible printing plates are wrapped around the cylinders and are held by a plate lock-up mechanism, wherein the flexible printing plates are mounted on the first and second plate cylinders side by side. Claim 1 further recites that each of the first and second blanket cylinders have substantially the same diameter as the associated plate cylinder. Claim 1 further recites that each of the first and second blanket cylinders are cantilevered in the first side wall of the housing, when removing the continuous blanket sleeves from the first and second blanket cylinders. Claim 1 further recites that the length to diameter ratio of the first and second plate cylinders is in the range between 5.8 : 1 and 9 : 1.

The Final Office Action alleges that Smith teaches a plate cylinder four pages wide and having four pages across, wherein each plate is the size of a page and that Harenza teaches a plate cylinder having four plates across and one plate around. The Final Office Action further alleges that Guaraldi et al. disclose a housing, sidewalls, first and second plate cylinders each having a plate lock-up mechanism, and first and second blanket cylinders each having an axially removable continuous blanket. The Final Office Action concludes that it would have been obvious to one of ordinary skill in the art to utilize the plate cylinder of Smith, as modified by Harenza, in the press of Guaraldi et al. to achieve well known benefits of blanket sleeves such as reducing vibrations in the press, providing near continuous printing, and allowing the blankets to be easily replaced. Applicants respectfully disagree for the reasons set forth below.

Smith purportedly relates to a dampener for a printing press. Smith states that the printing press includes a plate cylinder 10 adapted to carry four axially adjacent lithographic printing plates mounted about the peripheral surface thereof. See col. 2, lines 11 to 17. Nowhere, however, does Smith disclose, or even suggest, plate cylinders having a circumference substantially equal to the height of a single newspaper page, as recited in claim 1. Applicants note that there is a distinction between a "plate" and a "page." A one-around cylinder mounted plate may have more than one page mounted around its circumference depending on its height. Accordingly, disclosure by Smith of a one around plate in no way discloses, or even suggests, having the height of the plate sized to fit only one newspaper page, as recited in claim 1. Therefore, Smith does not disclose all of the limitations of claim 1.

To the extent that the Examiner is relying on the doctrine of inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art." See M.P.E.P. § 2112 (emphasis in original); and see, Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

The Final Office Action refers to the sentence bridging columns 1 and 2, column 2, lines 11 to 17 and column 3, lines 39 to 56 and alleges that Smith teaches a plate cylinder four pages wide and having four pages across, wherein each plate is the

size of a page. See Final Office Action at p. 3. Applicants respectfully disagree and submit that nowhere does Smith state that each plate is the size of a page, let alone does Smith state that each plate has the height of a newspaper page. Further, nowhere does Smith state how many pages can fit on a single plate. Applicants submit that it is common to place multiple pages around a single plate. Furthermore, as detailed below, nor would it have been obvious to one skilled in the art to reduce the size of the cylinders so as to receive a plate having the height of a single newspaper page given the expected increase of vibrations resulting from a decrease in diameter of the cylinders.

The Final Office Action refers to col. 3, lines 50 to 51 and alleges that Smith discloses a “page size printing plate.” Respectfully, the Final Office Action’s reference to Smith is taken out of context. Smith states as follows:

As illustrated in FIG. 1, a series of four baffles 34, 35, 36 and 37 are employed each of which is substantially equivalent in width to the width of a page size printing plate and thus each baffle serves to meter the volume of dampening fluid to its respective plate.

Col. 3, lines 48 to 52. The above sentence provides a description of the width of the four baffles 34, 35, 36 and 37. The sentence states that the baffles are equivalent in width to a page size printing plate. Smith uses a “page size printing plate” as a measure to describe the width of each baffle. Nowhere, however, does Smith disclose, or even suggest, that the actual printing plate to which dampening fluid is applied is page sized.

Further, Applicants respectfully submit that use of the descriptor “page size” in reference to the printing plate refers only to the width of the plate not the height. Clearly, in the above context, a plate having a multiple page height, for example, would still qualify as “page size” given that it would still be equivalent in width with each baffle. Reference to the plate as a “page sized printing plate” in the above excerpt, therefore, in now way indicates the height of the page. As indicated above, it is common to place multiple pages around a single plate.

Harenza purportedly relates to a printing press including a means for securing and registering thin printing plates on a cylinder driven in either direction. See col. 1, lines 9 to 12. The cylinder is stated to have a plate mounted “one around” and either two or four plates across extending the length of the cylinder. See col. 2,

lines 34 to 38. Nowhere does Harenza disclose, or even suggest, plate cylinders having a circumference substantially equal to the height of a single newspaper page, as recited in claim 1. As indicated above, a one-around cylinder mounted plate may have more than one page mounted around its circumference depending on its height. Therefore, Harenza does not disclose all of the limitations of claim 1. Nor does Harenza cure the deficiencies of Smith. The Final Office Action alleges that Harenza teaches a plate cylinder having four plates across and one plate around. However, the Final Office Action does not even allege that Harenza discloses plate cylinders having a circumference substantially equal to the height of a single newspaper page, as recited in claim 1.

Guaraldi et al. purportedly relate to a printing unit. Abstract. Guaraldi et al. state that the printing unit includes upper and lower plate cylinders 14 and 18 and that a single printing plate is wrapped around each plate cylinder by locking mechanisms. See col. 2, lines 49 to 53. Respectfully, nowhere do Guaraldi et al. disclose, or even suggest, plate cylinders having a circumference substantially equal to the height of a single newspaper page, as recited in claim 1. Therefore, Guaraldi et al. do not cure the deficiencies of Smith and Harenza.

To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Because the combination of Smith, Harenza and Guaraldi et al. does not disclose, or even suggest, all of the limitations of claim 1, including a plate cylinder having a circumference substantially equal to the height of a single newspaper page, it is respectfully submitted that said combination does not render obvious claim 1.

It is respectfully submitted that the cases of In re Fine, supra, and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), make plain that the Final Office Action's generalized assertions that it would have been obvious to modify or combine

the references do not properly support a § 103 rejection. It is respectfully submitted that those cases make plain that the Final Office Action reflects a subjective "obvious to try" standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

The PTO has the burden under section 103 to establish a *prima facie* case of obviousness. It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. This it has not done. . . .

**Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1598 to 1600 (citations omitted; italics in original; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

**Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].**

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted; italics in original).

That is exactly the case here since it is believed and respectfully submitted that the present Final Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding.

Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify or combine references to provide the claimed subject matter of the claims to address the problems met thereby. Accordingly, the Office must

provide proper evidence of a motivation for modifying or combining the references to provide the claimed subject matter.

The Final Office Action alleges that it would have been obvious to one of ordinary skill in the art to utilize the plate cylinder of Smith, as modified by Harenza, in the press of Guaraldi et al. to achieve well known benefits of blanket sleeves such as reducing vibrations in the press, providing near continuous printing, and allowing the blankets to be easily replaced. Applicants respectfully disagree.

Firstly, Applicants submit that the above allegations are completely unsupported and are based on Applicants' own application. Specifically, Applicants' Specification states the following:

Having outlined the state of the art and its attendant disadvantages, it is an object of the present invention to provide a high-performance 8-page newspaper printing press for printing four newspaper pages across, which is small in size, light in weight and easily accessible, which can be operated with a small number of staff and which allows an easy and quick change of printing plates and printing blankets.

Specification at p. 2, lines 13 to 17. None of the patents relied upon mention or refer to the motivation alleged in the Final Office Action for making the proposed combination.

The apparent reliance on Applicants' Specification makes plain that the present rejection is based on nothing more than hindsight. As stated by the Federal Circuit in the case of In re Dembiczak, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999):

Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher" . . . .

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. . . . Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the

inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight.

In re Dembiczak, 50 U.S.P.Q.2d at 1617 (citations omitted).

Further, Applicants respectfully traverse the Final Office Action's allegation that the benefits of blanket sleeves, such as reducing vibrations in the press, providing near continuous printing, and allowing the blankets to be easily replaced, are well known. It is respectfully requested pursuant to 37 C.F.R. § 1.104(d)(2) that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions.

As indicated above, Smith states that the printing press includes a plate cylinder 10 adapted to carry four axially adjacent lithographic printing plates mounted about the peripheral surface thereof. See col. 2, lines 11 to 17. Smith does not disclose, or even suggest, a blanket cylinder, let alone the relative size of the plate and blanket cylinders. Given the time frame of Smith, however, it is known that blanket cylinders were clamped at their ends in relatively large grooves in the blanket cylinder, which generally required a 2:1 blanket cylinder to plate cylinders diameter ratio to dampen vibrations. Harenza also does not directly disclose a blanket cylinder or the relative size of the blanket cylinder to the plate cylinder. However, a large vibration causing gap, required by the use of the two lock-up mechanism (see Figure 8), indicates that the blanket cylinders used with the plate cylinders generally would have a 2:1 diameter ratio; the larger blanket cylinders being used to dampen vibrations caused by the large gap in the plate cylinder.

Given the above, one skilled in the art would recognize that Smith and Harenza deal with 2:1 printing presses. Applicants submit that it would not have been obvious to take a plate cylinder used in a 2:1 printing press, such as Smith and Harenza, as suggested by the Final Office Action, and use it in a 1:1 printing press, such as Guaraldi et al. The relative size of the plate and blanket cylinders has a dramatic effect on the vibrations produced, and thus, on the overall functioning of the printing press. Accordingly, the plate and blanket cylinders are necessarily designed as pairs. Given this design reality, it would not have been obvious to mix and match pair elements, i.e., take the plate cylinder alone from the 2:1 printing press of Smith or Harenza and use it to replace the plate cylinder from the 1:1 printing press of Guaraldi

et al., even if it was obvious (which Applicants do not admit) to widen the Guaraldi et al. plate cylinder from one plate wide to four plates wide in light of Smith or Harenza. This is especially so given, as indicated above, that the plate cylinder of Guaraldi et al. is stated to roll against a continuous, i.e., no gap, blanket cylinder and that, as one skilled in the art would recognize, the plate cylinders of Smith and Harenza roll against a blanket cylinder having a gap.

The Final Office Action further alleges that Guaraldi et al. teach continuous blanket cylinders. Applicants submit that even given the existence of the continuous, and thus gapless, blanket of Guaraldi et al. it would not have been obvious to use a 1:1 plate cylinder and blanket cylinder pair, wherein the plates mounted on the plate cylinder have a height of a single newspaper page, as recited in claim 1. Assignee Heidelberg's own relevant product in this area prior to the filing date, the Galaxy newspaper press, was a 1:1 press with a four-across two-around plate cylinder. One skilled in the art, however, would not have found it obvious to have reduced the diameter of the plate cylinder from two-around to one-around, as claimed in claim 1, given the expected increase in vibrations and decrease in cylinder stiffness, which are both undesirable side effects. Applicants' have discovered, however, that when the plate and blanket cylinders have a 1:1 diameter ratio the cylinders have a thinner line of contact, which results in an increase in nip pressure and allows for reduced diameters without increased vibration. Therefore, Applicants submit that claim 1 is patentable over the combination of Smith, Harenza and Guaraldi et al. Accordingly, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection and allowance of claim 1.

As for claims 2, 5, 6, and 11, which depend from claim 1 and therefore include all of the limitations of claim 1, it is respectfully submitted that the combination of Smith, Harenza and Guaraldi et al. does not render obvious these claims for at least the same reasons provided above in support of the patentability of claim 1. In re Fine, supra (any dependent claim that depends from a non-obvious independent claim is non-obvious). Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection and allowance of claims 2, 5, 6 and 11.

### III. Rejection of Claims 3 and 4 Under 35 U.S.C. §103(a)

Claims 3 and 4 were rejected as unpatentable under 35 U.S.C. §103(a) over Smith in combination with Harenza, Guaraldi et al. and EP 644,048 ("Schneider et al."). Applicants respectfully submit that the combination of Smith, Harenza, Guaraldi et al. and Schneider et al. does not render obvious claims 3 and 4 for the following reasons.

Applicants submit that Schneider et al. do not cure the deficiencies of Smith or Harenza and Guaraldi et al. Specifically, Schneider et al. do not disclose, or even suggest, plate cylinders having a circumference substantially equal to the height of a single newspaper page, as recited in claim 1. Claims 3 and 4 depend from claim 1 and therefore include all of the limitations of claim 1. Accordingly, Applicants submit that claims 3 and 4 are patentable for at least the reasons provided above in support of the patentability of claim 1. In re Fine, supra. Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection and allowance of claims 3 and 4.

Regarding claim 4, Applicants submit the following additional reasons in support of patentability. Applicants respectfully submit that the combination of Smith, Harenza, Guaraldi et al. and Schneider et al. does not disclose that each of the plate cylinders has a circumferential register adjustment system configured to provide circumferential register adjustment to its respective plate cylinder, as recited in amended claim 4. Support for the amendment to claim 4 can be found, for example, at p. 9, lines 11 to 22. The Final Office Action at p. 3 refers Applicants to col. 1, lines 55 to 59 of Harenza, which states as follows:

Still another object of the present invention is to provide a plate lockup for a reversible cylinder which includes a novel means for effecting peripheral and axial adjustment of a printing plate at the leading edge position regardless of direction of rotation.

(emphasis added) However, the above reference discusses a means for adjusting a printing plate not a plate cylinder, as recited in claim 4. Therefore, Applicants submit that the combination of Smith, Harenza, Guaraldi et al. and Schneider et al. does not render obvious amended claim 4.

**IV. Rejection of Claim 7 Under 35 U.S.C. §103(a)**

Claim 7 was rejected as unpatentable under 35 U.S.C. §103(a) over Smith in combination with Harenza, Guaraldi et al. and U.S. Patent No. 5,152,222 ("Okamura et al."). Applicants submit that Okamura et al. do not cure the deficiencies of Smith, Harenza and Guaraldi et al. Specifically, Okamura et al. do not disclose, or even suggest, plate cylinders having a circumference substantially equal to the height of a single newspaper page, as recited in claim 1. Claim 7 depends from claim 1 and therefore includes all of the limitations of claim 1. Accordingly, Applicants submit that claim 7 is patentable for at least the reasons provided above in support of the patentability of claim 1. In re Fine, supra. Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection and allowance of claim 7.

**V. Rejection of Claims 8 to 10, 13 and 14 Under 35 U.S.C. §103(a)**

Claims 8 to 10, 13 and 14 were rejected as unpatentable under 35 U.S.C. §103(a) over Smith in combination with Harenza, Guaraldi et al., Okamura et al. and U.S. Patent No. 5,617,788 ("Horiguchi et al."). Applicants submit that Horiguchi et al. do not cure the above noted deficiencies of Smith, Harenza, Guaraldi et al. and Okamura et al. Specifically, Horiguchi et al. do not disclose, or even suggest, plate cylinders having a circumference substantially equal to the height of a single newspaper page, as recited in claim 1. Claims 8 to 10, 13 and 14 ultimately depend from claim 1 and therefore include all of the limitations of claim 1. Accordingly, Applicants submit that claims 8 to 10, 13 and 14 are patentable for at least the reasons provided above in support of the patentability of claim 1. In re Fine, supra. Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection and allowance of claims 8 to 10, 13 and 14.

**VI. Rejection of Claim 12 Under 35 U.S.C. §103(a)**

Claim 12 was rejected as unpatentable under 35 U.S.C. §103(a) over Smith in combination with Harenza, Guaraldi et al. and "applicant's admission of prior art". Applicants respectfully submit that the combination of Smith, Harenza, Guaraldi et al., Andersson et al. and "applicant's admission of prior art" does not render obvious claim 12 for the following reasons.

As an initial matter, in addressing the merits of this rejection, Applicants do not concede the correctness of the Final Office Action's characterization of the subject matter on page 4 of the Specification as prior art, but will proceed, for the sake of argument only, on the premise that the Final Office Action's characterization is accurate. Therefore, when framed accordingly, Applicants' argument is that even if the Final Office Action is correct in characterizing page 4 of the Specification as prior art, the invention of claim 12 would still be patentable over such alleged admitted prior art.

Applicants submit that the alleged admitted prior art does not cure the deficiencies of Smith, Harenza and Guaraldi et al. Specifically, the alleged admitted prior art does not disclose, or even suggest, plate cylinders having a circumference substantially equal to the height of a single newspaper page, as recited in claim 1. Claim 12 depends from claim 1 and therefore includes all of the limitations of claim 1. Accordingly, Applicants submit that claim 12 is patentable for at least the reasons provided above in support of the patentability of claim 1. In re Fine, supra. Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. §103(a) rejection and allowance of claim 12

## **VII. Nonstatutory Double Patenting Rejection of Claims 1 to 14**

Claims 1 to 14 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 12 of U.S. Patent No. 6,374,731. The Final Office Action indicates, however, that a timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) may be used to overcome this rejection. Applicants will prepare a terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) to overcome the nonstatutory double patenting rejections of claims 1 to 14 upon withdrawal of all other rejections and/or when the claims are indicated to be in final form for allowance. Accordingly, an indication that all of the pending claims are allowable post filing of a terminal disclaimer is respectfully requested.

**VIII. Conclusion**

It is therefore respectfully submitted that the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

**KENYON & KENYON**

Dated: July 20, 2004

By: 

Abraham P. Ronai  
Reg. No. 41,275  
One Broadway  
New York, New York 10004  
(212) 908 - 6408  
**CUSTOMER NO. 26646**